

REMARKS

In the Action, claims 1-38 were pending, and upon entry of the present paper, claim 3 is canceled without prejudice or disclaimer, and claim 39 is added. Claims 1-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over an alleged combination of Shore (U.S. Patent Pub. No. 2003/0149662) and Crookham et al. (U.S. Patent No. 6,681,110). Applicants respectfully traverse these grounds of rejection.

Availability of Crookham et al.

At the outset, Applicants note that the Action has relied on Crookham et al., which is a U.S. patent having a filing date of June 30, 2000, and claiming priority to a provisional application (Serial No. 60/142,109) filed on July 2, 1999. The present application claims priority to a provisional application filed on April 25, 2000. Although Applicants address Crookham et al. on the merits below, Applicants make no representation regarding whether Crookham et al. is even available as prior art, and expressly reserve the right to antedate and/or disqualify this patent should the need arise in the future.

Independent Claims 1, 6, 7, 12, 13, 29, 33, 34 and 38, and Dependent Claims 2, 4-5, 8-11, 14-15, 30-32, 35-37 and 39

In rejecting claim 1, the Action primarily relies on Shore. Shore relates generally to a system in which a user's personal data assistant (PDA) can be used to make purchases at Point of Purchase (POP) terminals. The Shore PDA includes account numbers to be used for payment, and "[t]he PDA would communicate the account number to the POP terminal and would then update the user's account information temporarily held in the PDA." Shore [0063]. However, the Action concedes that Shore does not anticipate claim 1, noting that "Shore however fails to explicitly disclose a program to take control of the wireless mobile device's menuing, interaction

and display functions.” Action, p. 3. To address this deficiency in Shore, the Action combines Shore with Crookham et al.

Crookham et al. relates to turning the lights on and off at baseball stadiums, parking lots, golf courses, playgrounds, etc. from a remote location. Crookham et al., col. 1, lines 16-20. Crookham et al. starts with a central controller 10 that stores the lighting schedules for the baseball stadium. See, e.g., col. 8, lines 47-53; see also Fig. 1. At the appropriate times (e.g., when a stadium needs to have its lights turned on), central controller 10 places a cellular call to an equipment controller at the baseball stadium, where a portion of the call’s MIN corresponds to a predefined lighting operation at the stadium. Crookham et al. Fig. 9 illustrates the remote equipment controller (REC) 14 used at the stadium. Cellular radio 20 receives the call, and forwards the MIN to a programmable logic controller (PLC) 50. The PLC 50 uses a portion of the MIN to consult a memory map to identify the function assigned to the particular MIN, and activates/deactivates the appropriate contactors 54 to cause lights 16 to turn on/off accordingly. See, e.g., col. 15, lines 19-26.

The Action relies on Crookham et al. to show the step of transmitting “a program to take control of the wireless mobile device's menuing, interaction and display functions,” and cites to Crookham et al.’s association of a function to a cellular telephone Mobile Identification Number (MIN). However, contrary to the Action’s allegation, the Crookham et al. MIN does not “take control of the wireless mobile device's menuing, interaction and display functions,” as recited in claim 1. The MIN is received at the cellular radio 20 as part of the call from the central controller 10, and is passed along to PLC 50. There is no teaching or suggestion that the MIN will somehow take control of the radio’s 20 menuing, interaction and display functions.

The only other elements in Crookham et al. that handle the MIN are the PLC 50 and the non-volatile memory identifying the appropriate function, and neither of these elements is disclosed in Crookham et al. as a “wireless mobile device.” Crookham et al. fails to teach or suggest the transmission of “a program to take control of the wireless mobile device's menuing, interaction and display functions,” and does not overcome the deficiencies of Shore.

Furthermore, there is no proper motivation for the combination -- the Action's proffered motivation relies on “remote monitoring” and “status information,” and yet cites nothing from the references to suggest that such features are desirable or needed in Crookham et al. and Shore. Indeed, Shore appears to already have all the “remote monitoring” and “status information” it needs – e.g., communication interface 795 allows the PDA to communicate with a PC to synchronize its data with underlying servers, such as bank servers. See Shore [0065]. Shore obtains this information without transmitting “a program to take control of the wireless mobile device's menuing, interaction and display functions,” and the Action has cited nothing to suggest that Shore's existing “monitoring” features are inadequate, or require the Crookham et al. baseball stadium system, to achieve “remote monitoring” or to obtain “status information.”

By removing a feature Shore already has, and replacing it with a different one that it neither needs nor wants, the Action's proposed modification alters the very principle of operation of the Shore system. It is a well-established principle that a proposed modification cannot change the principle of operation of a reference. See MPEP §2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims prima facie obvious.”). Here, the modification proposed by the Office Action would change the principle of operation of the Shore and/or Crookham systems, and therefore, the

combination is not sufficient for meeting the prima facie burden necessary for an obviousness rejection.

For at least these reasons, claim 1 distinguishes over the art of record, and is in condition for allowance. Claims 2-5 depend from claim 1, and are allowable for at least the same reasons as claim 1, and further in view of the various advantageous and novel features recited therein.

Additionally, independent claims 6, 7, 29, 33 and 34 also recite the transmission of “a program to take control of the wireless mobile device's menuing, interaction and display functions,” independent claims 12 and 38 recite “means for taking control of the wireless mobile device's menuing, interaction and display functions,” and independent claim 13 recites “the third code mechanism takes control of the wireless mobile device's menuing, interaction and display functions.” The art of record fails to teach or suggest such features, and these claims are similarly allowable. Claims 8-11, 14-15, 30-32 and 35-37 each depend from one of these independent claims, and are allowable for at least the same reasons as their base claim, and further in view of the various advantageous and novel features recited therein.

Newly added dependent claim 39 also distinguishes over the art of record. Neither Shore nor Crookham et al. teaches or suggests a program that “causes a display on said wireless mobile device to display a list of products available for purchase from said vendor device and prices of said products,” and has the additional method steps recited in claim 39.

Independent Claim 16 and 28 and Dependent Claims 17-27

Amended independent claim 16 recites, among other features, “the microprocessor in the product device taking electronic control of the wireless mobile device when said wireless mobile device enters a range of said product device.” None of the art of record, alone or in combination

(assuming, *arguendo*, that they may be combined at all), teaches or suggests the novel apparatus recited in claim 16. The Action concedes that Shore fails to teach or suggest the transmission of the “program to take control of the wireless mobile device ...” recited in claim 1, and Applicants submit that Shore also fails to teach or suggest the claim 16 “microprocessor taking electronic control of the wireless mobile device when said wireless mobile device enters a range of said product device.”

The Action’s other applied reference, Crookham et al., similarly fails to teach or suggest such an apparatus. As discussed above, the Crookham et al. MIN (the alleged program for taking control) is sent by the central controller 10 based on the predetermined lighting schedule, and not on whether the REC 14 (the alleged “wireless mobile device”) “enters a range of said product device,” as recited in amended claim 16.

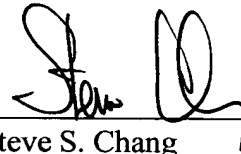
For at least these reasons, Applicants submit that amended independent claim 16 distinguishes over the art of record (even assuming, *arguendo*, that the art is combinable). Claim 28 has also been amended to recite “for taking electronic control of the wireless mobile device when said wireless mobile device enters a range of said product device,” and distinguishes over the art of record as well. Claims 17-27 depend from claim 16, and are allowable for at least the same reasons as claim 16, and further in view of the various advantageous and novel features recited therein. For example, claim 22 recites that “the product device is a cigarette vending machine;” claim 23 recites “the product device is a copy vending machine;” claim 26 recites “the product device is a parking meter;” and none of the art of record teaches or suggests these types of product devices. Claim 27 recites “the micropayment system is a Qpass micropayment machine,” and none of the art of record teaches or suggests such a micropayment system.

Conclusion

For at least the reasons set forth above, Applicants respectfully submit that pending claims 1-2 and 4-39 distinguish over the art of record, and are in condition for allowance. Should the Examiner wish to have further discussion and/or amendment to place the application in condition for allowance, the Examiner is invited to telephone the Applicants' undersigned representative at the number appearing below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steve S. Chang', is written over a horizontal line.

Steve S. Chang
Reg. No. 42,402
BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Washington, D.C. 20001

202 824-3000